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10/702,373	11/05/2003	Hiroshi Kanno	60202(49381)	8448

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EXAMINER

DEBNATH, SUMAN

ART UNIT	PAPER NUMBER
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2196

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/702,373

Applicant(s)

KANNO, HIROSHI

Examiner

Suman Debnath

Art Unit

2196

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/05/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/05/2003
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-21 are pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The claims 1-21 are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

5. Claim 1 recites "an operator" in line 6 and in line 10. It is unclear if both the limitations are same.

Claim 1 recites "first fingerprint information" in line 5 and "the fingerprint information" in line 6 and 6. It is unclear if all these limitations are same.

Claim 1 recites "second fingerprint information" in line 9 and "the fingerprint information" in line 10 and 12. It is unclear if all these limitations are same. Furthermore, it is also unclear if "the fingerprint information" in line 10 and 12 are referring to "the fingerprint information" in line 6.

Art Unit: 2196

Claim 1 recites "both of fingerprint" in line 14. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Naofumi (Pub. No.: 2001-045192).

8. As to claim 19, Naofumi discloses a terminal apparatus connected to a scanner in a manner permitting communications so as to transmit an operation instruction for causing said scanner to read a document image ([0017], lines 2-4), comprising: fingerprint information reading means for reading a fingerprint information of an operator ([0019], lines 2-3); fingerprint information storing means for temporarily storing the fingerprint information read by said fingerprint information reading means ([0019], lines 2-5); fingerprint information collating means for collating a fingerprint information acquired by said scanner with the fingerprint information read by said fingerprint

Art Unit: 2196

information reading means by means of communications with said scanner ([0028], lines 1-4 and [0017], lines 3-5); and operation permitting means for permitting the operation of said scanner in response to the inputted operation instruction on the basis of the result of collation in said fingerprint information collating means ([0028], lines 1-6).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 1-18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naofumi in view of Takahashi (Pub. No.: US 2001/0016912 A1).

11. As to claim 1, Naofumi discloses an image processing system including: a scanner for reading a document image ([0017], line 3); and a terminal apparatus connected to said scanner in a manner permitting communications so as to transmit an operation instruction to said scanner ([0017], lines 2-4); wherein said scanner comprises: first fingerprint information reading means for reading the fingerprint information of an operator ([0019], lines 2-3); and first fingerprint information storing means for storing temporarily the fingerprint information read by said first fingerprint

information reading means ([0019], lines 2-5); and both of fingerprint information collating means for collating the fingerprint information stored in said first fingerprint information storing means with the fingerprint information read by said second fingerprint information reading means by means of communications between said scanner and said terminal apparatus ([0028], lines 1-4 and [0017], lines 3-5); and operation permitting means for permitting the operation of said scanner in response to the operation instruction inputted through said terminal apparatus on the basis of the result of collation in said fingerprint information collating means are provided either in said scanner or in said terminal apparatus, or alternatively any one of said fingerprint information collating means and said operation permitting means is provided in said scanner ([0028], lines 1-6).

Naofumi doesn't explicitly disclose terminal apparatus comprises: second fingerprint information reading means for reading the fingerprint information of an operator; and second fingerprint information storing means for storing temporarily the fingerprint information read by said second fingerprint information reading means; Any one of said fingerprint information collating means and said operation permitting means is provided in the terminal apparatus. However, Takahashi discloses terminal apparatus (FIG. 1) comprises: second fingerprint information reading means for reading the fingerprint information of an operator (FIG. 1, [0044], lines 8-13); and second fingerprint information storing means for storing temporarily the fingerprint information read by said second fingerprint information reading means (FIG. 1, [0044], lines 19-23 and [0009],

lines 14-15); Any one of said fingerprint information collating means and said operation permitting means is provided in the terminal apparatus (FIG. 3, [0045], lines 20-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Naofumi by including a method for reading fingerprint information by terminal apparatus as taught by Takahashi in order to "prevent the loss, stain, and information leakage of print results when the operator does not collect the print results immediately (Takahashi, [0002], lines 13-18)". Furthermore, one would be motivated to do so in order to maintain the security of the transferred data over the communication network, which could be intercepted by any unauthorized user to view.

12. As to claim 16, Naofumi discloses a scanner connected to a terminal apparatus in a manner permitting communications so as to receive an operation instruction for reading a document image ([0017], lines 2-4), comprising: fingerprint information reading means for reading a fingerprint information of an operator ([0019], lines 2-3); fingerprint information storing means for temporarily storing the fingerprint information read by said fingerprint information reading means ([0019], lines 2-5); fingerprint information collating means for collating the fingerprint information read by said fingerprint information reading and terminal apparatus by means of communications with said terminal apparatus ([0028], lines 1-4 and [0017], lines 3-5); and operation permitting means for permitting the operation in response to the operation instruction on

Art Unit: 2196

the basis of the result of collation by said fingerprint information collating means ([0028], lines 1-6).

Naofumi doesn't explicitly disclose fingerprint information reading means with fingerprint information acquired by the terminal apparatus; Permitting the operation in response to the operation instruction inputted through the terminal apparatus. However, Takahashi discloses fingerprint information reading means with fingerprint information acquired by the terminal apparatus (FIG. 1, [0044], lines 8-13); Permitting the operation in response to the operation instruction inputted through the terminal apparatus ([0061], lines 9-13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Naofumi by including a method for reading fingerprint information by terminal apparatus as taught by Takahashi in order to "prevent the loss, stain, and information leakage of print results when the operator does not collect the print results immediately (Takahashi, [0002], lines 13-18)". Furthermore, one would be motivated to do so in order to maintain the security of the transferred data over the communication network, which could be intercepted by any unauthorized user to view.

13. As to claim 2, Naofumi discloses wherein when collation by said fingerprint information collating means is matches ([0028], lines 1-4), said operation permitting means permits the operation of said scanner ([0028], lines 4-7 and [0029]). Naofumi

doesn't explicitly disclose permitting the operation in response to the operation instruction inputted through the terminal apparatus. However Takahashi discloses permitting the operation in response to the operation instruction inputted through the terminal apparatus ([0061], lines 9-13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Naofumi by including a method for inputting the operation instruction through the terminal apparatus as taught by Takahashi in order to "prevent the loss, stain, and information leakage of print results when the operator does not collect the print results immediately (Takahashi, [0002], lines 13-18)". Furthermore, one would be motivated to do so in order to maintain the security of the transferred data over the communication network, which could be intercepted by any unauthorized user to view.

14. As to claims 3 and 8, Naofumi discloses the image processing system wherein said scanner comprises: document image reading means for reading document image before receiving said operation instruction ([0019], lines 1-2); and associated information generating means for generating associated information in which the document image information read by said document image reading means ([0019], 1-2) and the fingerprint information read by said first fingerprint information reading means are associated with each other ([0019], lines 1-4); and associated information storing means connected to said scanner in a manner permitting communications so as to store

the associated information generated by said associated information generating means is further included ([0020], [0021] and [0019], lines 2-4).

15. As to claims 4 and 9, Naofumi discloses the image processing system wherein a server provided with said associated information storing means is connected to said scanner ([0008], lines 2-4 and [0033], lines 5-7) and said terminal apparatus in a manner permitting communications ([0021]).

16. As to claims 5, 10 and 13, Naofumi discloses the image processing system wherein either said scanner or said terminal apparatus comprises: associated fingerprint information collating means for collating the fingerprint information stored in said first fingerprint information storing means with the fingerprint information contained in said associated information of the past time ([0022], lines 1-5); and operation inhibiting means for inhibiting the operation of said scanner when the collation by said associated image information collating means matches and the collation by said associated fingerprint information collating means does not match ([0028], lines 1-6).

Naofumi doesn't explicitly disclose associated image information collating means for collating the document image information read by said document image reading means with the image information contained in said associated information of a past time. However, Takahashi discloses associated image information collating means for collating the document image information read by said document image reading means

Art Unit: 2196

with the image information contained in said associated information of a past time (FIG. 3, step B5, [0049], lines 10-14).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Naofumi by including a method for associating document image information of a past time as taught by Takahashi in order to "prevent the loss, stain, and information leakage of print results when the operator does not collect the print results immediately (Takahashi, [0002], lines 13-18)". Furthermore, one would be motivated to do so in order to maintain the security of the transferred data over the communication network, which could be intercepted by any unauthorized user to view.

17. As to claims 6, 11, 14, 17 and 20, Naofumi discloses the image processing system wherein said scanner and/or said terminal apparatus comprises associated information reading operation of image by said scanner is completed or when a predetermined time has elapsed before reading operation of image by said scanner completed ([0031]).

Naofumi doesn't explicitly disclose deleting associated information when reading operation completed or when a predetermined time has elapsed before reading operation of image completed. However, Takahashi discloses deleting associated information when reading operation completed or when a predetermined time has

elapsed before reading operation of image completed (FIG. 3, steps B7-B8, [0049], lines 17-18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Naofumi by including a method for deleting associated information when reading operation completed as taught by Takahashi in order to "prevent the loss, stain, and information leakage of print results when the operator does not collect the print results immediately (Takahashi, [0002], lines 13-18)". Furthermore, one would be motivated to do so in order to maintain the security of the transferred data over the communication network, which could be intercepted by any unauthorized user to view.

18. As to claims 7, 12, 15, 18 and 21, Naofumi discloses the image processing system wherein when a document is removed before the reading operation of the image by said scanner is completed, said associated information deleting means does not delete the associated information generated for the removed document ([0031], which describes a checking is done whether the transfer of all images was completed and if not completed returns to complete the transfer).

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See accompanying PTO 892.

Art Unit: 2196

Rublee et al. (Pub. No.: US 2003/0043416 A1) discloses a method for sending scanned document to sender's computer and identity of the sender is determined by a network-login step the sender uses to access the scanner.

Taslitz (Pub. NO.: US 2003/0182151 A1) discloses a method for associating scanned document with fingerprint data.

Shamos (Patent Number: 5,193,855) discloses a patient and healthcare provider identification system.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suman Debnath whose telephone number is 571 270 1256. The examiner can normally be reached on 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil M. El-Hady can be reached on 571 272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

Art Unit: 2196

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SD


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